

REMARKS

Upon entry of the amendments herein, claims 1-6, 8-20, 24-31 and 34-37 remain pending in the application. Claim 1 has been amended, and claims 32 and 33 have been canceled herein. No new matter has been introduced by any of these amendments. Of the pending claims, 12-20, 24-31 and 35-37 currently stand withdrawn pending the possibility of rejoicing upon agreement as to allowable subject matter in the claims now being considered by the Examiner.

Applicants acknowledge the Examiner's withdrawal of the previous rejections under 35 U.S.C. §§101 and 112, second paragraph.

The claims under examination remain rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Although the claims remain rejected under the same section of the statute, the Examiner has in effect replaced the previous basis for the rejection with an assertion that claim 1 in its present form contains new matter. The Examiner acknowledges that the instant specification discloses "the possible link of the Nurrl gene and the neuro-psychiatric disorder" and acknowledges that the specification also "describes fragments of Nurrl." However the Examiner maintains that there is nothing in the specification teaching a link between Nurrl fragments and the disorders in question. Applicants emphatically disagree with this assertion.

Applicants wish to go on record as stating that the Examiner's assertion of new matter is particularly inappropriate. Again, the Examiner acknowledges that the specification teaches a link between the disclosed mutations in the Nurrl gene and some psychotic disorders and that the specification also teaches fragments of Nurrl. However, the

Examiner regards these as two separate concepts and regards the merging of these two concepts as constituting new matter. As pointed out previously but apparently unappreciated by the Examiner, it would be no great leap for one of skill in the art to understand and accept that the effects of the mutations in functional fragments and variants of the wild-type gene could be the same as those manifested by the occurrence of those mutations in the full-length gene. Further in response to the Examiner's assertion that there is no link provided between the recited fragments and the recited disorders, Applicants wish to remind the Examiner that the language in question in fact recites a link between specific mutations in the genes or functional fragments and the recited disorders and that these mutations, by the Examiner's own acknowledgment, have been shown to be linked to the disorders. It must be clear that it would be anticipated that the mutations would have the same manifestations, whether they occurred in the entire gene or in a functional fragment or variant thereof.

The inappropriateness of the rejection notwithstanding, Applicants have amended the claims herein in the interest of expediting the prosecution of the application to allowance. Claim 1 has been amended by deletion of the language found objectionable by the Examiner and replacement of that language with language in keeping with what the Examiner is on record as having acknowledged to be supported by the instant specification.

On page 4 of the Office Action mailed October 25, 2007, the Examiner states: "As for the function of the Nurrl gene, the specification discloses that it can bind to NurRE and direct transcription, wherein the three mutations in exon 3 results [sic] in the impairment of its function." To be precise, the teaching is that the product of the Nurrl gene can bind to NurRE

and direct transcription. In any case, the Examiner has clearly acknowledged the adequacy of the disclosure of the specification in this regard. Accordingly, the language added by amendment in Applicants' previous response has been replaced by language reciting a common feature of all members of the genus recited in claim 1, the feature that they have impaired ability to bind to NurRE and to effect transcriptional activity. Support for this amendment, acknowledged by the Examiner to exist in the specification, can be found, for example, in the passage running from page 24, line 22 through page 26, line 2.

It must be emphasized that one of skill in the art would find credible the assertion that fragments and variants of the Nurrl gene containing the mutations in question would also encode gene products with impaired ability to bind to NurRE and to activate transcription. The subject matter of amended claim 1 meets all the requirements of 35 U.S.C. §112, first paragraph and all other criteria for patentability.

Claims 32 and 33 stand newly rejected under 35 U.S.C. §103(a) as being obvious in light of a sequence having the accession number NM_006168 and found in the reference of Mages et al. Cancellation of these claims by amendment herein renders moot the rejection. The cancellation is made without prejudice, and Applicants maintain the right to resume prosecution of the claimed subject matter in a continuation application.

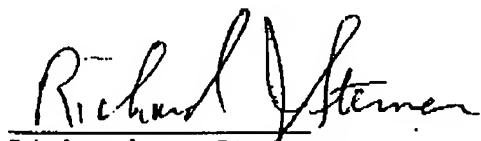
In view of the amendments herein to claim 1, the new-matter issue raised is moot. Furthermore, not only does the new language added to claim 1 not constitute new matter but it is fully supported by the specification and complies with the criteria for fulfilling the written description requirement. Similarly, the prior art issue raised by the Examiner is now moot. Reconsideration and allowance of the application with

still-pending, elected claims 1-6, 8-11 and 34 are respectfully requested. It is also respectfully requested that all, or at least some, of the method claims be rejoined to the allowable composition claims and also allowed; any claims not ultimately rejoined will be canceled by Applicants. It is requested that the Examiner contact the undersigned in this regard prior to the mailing of another Office Action. Should any other matters require attention prior to allowance, it is similarly requested that the Examiner contact the undersigned.

No fees should be due. However, should it be determined that a fee is required for any reason in connection with this communication, the Commissioner is hereby authorized to charge it to Deposit Account No. 23-1703.

Dated: November 18, 2008

Respectfully submitted,


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